

## REMARKS

Claims 1-14 have been rejected. Claims 1 and 7 have been amended and claim 2 to 4, 6, and 8 have been canceled. Claims 1, 5, 7, and 9 to 14 are, therefore, presently pending. Applicants respectfully request reconsideration in view of the foregoing amendments and the remarks hereinbelow.

### **Rejection of Claims 1, 3, 6, 7 and 11 under 35 USC §102(b):**

Claims 1, 3, 6, 7 and 11 have been rejected under 35 USC §102(b) as being anticipated by the patent to Ohbayashi et al. (U. S. 6,492,005) In particular, the Examiner notes column 13, lines 57-62.

This rejection is respectfully traversed. In fact, Ohbayashi states as follows:

Listed as cationic fixing agents are water-soluble cationic polymers having quaternary ammonium bases, silane coupling agents having quaternary ammonium bases, and the like....Further the silane coupling agent having quaternary ammonium bases reacts with the surface of fine inorganic particles such as silica and the like, and results in an increase in diffusion resistance. Thus it is capable of fixing dyes. [Emphasis added, col. 18, line 55 to col. 19, line 8].

Thus, Ohbayashi teaches the use of silane coupling agents with silica and the like. In the event of a different inorganic particle such as alumina, obviously a different cationic fixing agent, such as a cationic polymer, could be used. In fact, since Ohbayashi mentions the possibility of using alumina or cationic surface treated alumina but only mentioned treatment of silica and the like with silane coupling agents, it can be assumed that Ohbayashi definitely did not envision alumina or other non-silicon containing inorganic particles surface treated with a silane coupling agent.

In further support of this conclusion, the Examples in Ohbayashi all use silica dispersions in combination with either no cationic fixing agent or a cationic polymer. The Ohbayashi patent has no example of a non-silicon inorganic particle and/or a silica coupling agent.

With respect to the Examiner's reference to col. 13, where "cationic surface treated colloidal silica and alumina" is mentioned, it is respectfully submitted that this does not refer to the surface treatment of the alumina with a silane coupling agent, since silane coupling agents are only mentioned later in

the patent. Based on column 13, lines 53-59, it would appear that this surface treatment refers to one involving a “gas phase method.”

Hence, Ohbayashi does not anticipate the present invention.

**Rejection of Claims 1-14 under 35 U.S.C. 103(a):**

Claims 1-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the patent to Ohbayashi et al. (hereafter “Ohbayashi”). The Examiner states that Ohbayashi teaches an inkjet recording element comprising a support and an image-receiving layer comprising alumina particles having their surfaces treated with a silane coupling agent having a hydrophilic, organic moiety.

This rejection is respectfully traversed. As explained above, Ohbayashi nowhere states that alumina particles are treated with silane coupling agents, but rather that “silica and the like” are so treated. Alumina is not like silica. The surfaces are chemically very different. There is no motivation in Ohbayashi to treat alumina with a silane coupling agent, especially since a dye fixing agent is not even considered necessary and, if used, Ohbayashi generally prefers a cationic polymer, although noting that alternatively a silane coupling agent could be used with silica and the like. Moreover, it would not have been predictable that the surface of non-silicon containing inorganic particles could be effectively or successfully treated with silane coupling agents, especially in the presence of the other ingredients in the mixture such as polyvinyl alcohol which contains hydroxyl groups known to react with silane coupling agents. Furthermore, Ohbayashi nowhere mentions the cracking problem that is solved by the present invention, as demonstrated by the comparative results in Table 2 on page 14 of the specification.

**Provisional Rejection of Claims 1-4 under Obviousness-Type Double Patenting:**

Claims 1-4 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of co-pending Application No. 10/020,762. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of SN 10/020,762 constitute the obvious method of using the instant article claims.

In order to obviate this rejection, attached hereto is a Terminal Disclaimer for co-pending Application No. 10/020,762.

It is respectfully submitted, therefore, that in view of the above amendments and remarks, that this application is now in condition for allowance, prompt notice of which is earnestly solicited.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 30,721

Chris P. Konkol/clb  
Rochester, NY 14650  
Telephone: 585-722-0452  
Facsimile: 585-477-1148